

REMARKS

Claims 1-37 have been examined, and claims 5-10, 12-21, 26-31, and 33-37 have been rejected under 35 U.S.C. § 112, second paragraph. Also, claims 1-6 and 22-25 have been rejected under 35 U.S.C. § 102(a), and claims 11 and 32 have been rejected under 35 U.S.C. § 103(a).

I. Preliminary matters

A. Objection to the abstract

The Examiner has objected to the abstract because it exceeds 150. Applicants submit that the amendments to the abstract overcome the objection.

B. Objection to the disclosure

The Examiner has objected to the disclosure because, in several places, it refers to hyperlinks. Applicants are not exactly sure of the basis for, or the rationale underlying, the objection.

Upon reading the specification, Applicants assume that the Examiner may believe that the URI contained on page 24, line 16, of the application, the HTTP request contained on page 25, line 4, of the application, and/or other similar alphanumeric strings contained in the application are electronic “links,” which are contained in the softcopy of the application and which are used to electronically access an actual website or webpage. If this assumption is correct, Applicants submit that such alphanumeric strings are not electronic “links” but are, instead, non-limiting examples of data that are communicated between various components of

the illustrative, non-limiting embodiments described the application. On the other hand, if Applicants' assumption is incorrect, Applicants request the Examiner to clarify his objection.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claims 5-10, 12-21, 26-31, and 33-37 have been rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite.

A. Claim 5

The Examiner maintains that claim 5 is indefinite because the phrase “generates the first upstream Internet message based on the first upstream Internet address” is unclear. Applicants are not sure why the Examiner contends that such phrase is ambiguous. Since the phrases “first upstream Internet message” and “first upstream Internet address” are previously recited in claim 5 or base claim 1, Applicants assume that the Examiner is not contending that these phrases are unclear. Therefore, Applicants assume that the Examiner's rejection centers on the term “generates”

According to *Webster's Revised Unabridged Dictionary (1996 and 1998)*, the term “generate” means, among other things, to “produce,” “originate,” and/or “cause to be.” Thus, the claimed phrase states that a first upstream Internet message is produced, is originated, or is created based on a first upstream Internet address. Applicants submit that such limitation clearly defines the metes and bounds of the relevant portion of claim 5. Specifically, if a device generates a first upstream Internet message based on the first upstream Internet address, the above limitation reads on the device. On the other hand, if a device does not generate a first

upstream Internet message based on the first upstream Internet address, the above limitation does not read on the device.

An illustrative, non-limiting example of an embodiment that generates a first upstream Internet message based on a first upstream Internet address is shown in Figs. 3, 7, and 8 and described at pages 24 and 25 of the present application. Specifically, a first upstream mobile terminal message (e.g. an SMS message) is at least indirectly created from a communication from a mobile terminal 110 (Fig. 2), and a protocol converting controller (e.g. a CTW converter 140) receives the mobile terminal message via the SMS center connector 1403. (Page 23, lines 18-24, and page 24, lines 4-6).

The SMS center connector 1403 outputs the mobile terminal message to the session resolution table 1405, and if the mobile terminal 110 currently is not involved in a session, the session resolution table 1405 outputs a “No Session” signal back to the connector 1403. (Page 24, lines 6-10). Upon receiving the “No Session” signal, the SMS center connector 1403 outputs the mobile terminal message to an SMS/URI table 1401, which selects a first upstream Internet address (e.g. a URI (e.g. <http://www.mobileinfo.com/default.asp>)) based on the mobile terminal message and which outputs the upstream Internet address back to the SMS center connector 1403. (Page 24, lines 12-18).

The SMS center connector 1403 outputs the first upstream Internet address (e.g. the URI) and the mobile terminal message to an HTTP request manager 1404. (Page 24, lines 18-19). The HTTP request manager 1404 generates a first upstream Internet message (e.g.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appl. No. 09/599,534

<http://www.mobileinfo.com/default.asp-?mobilenum=111111&text=>) based on the first upstream Internet address (e.g. the URI). (Page 24, line 19, to page 25, line 5).

In light of the discussion above, Applicants submit that the language of original claim 5 is definite and satisfies the requirements of 35 U.S.C. § 112, second paragraph. Nonetheless, since claim 5 has been canceled without prejudice or disclaimer, the rejection is moot.

B. Claims 6-10

Since claims 6-10 were rejected under 35 U.S.C. § 112, second paragraph, because they were dependent upon canceled claim 5, Applicants submit that the discussion above likewise traverses the rejection of claims 6-10.

C. Claim 12

The Examiner maintains that claim 12 is indefinite because the phrase “wherein first downstream Internet address further comprises a first downstream identification and a first selected Internet address” is unclear. Applicants submit that claim 12 contains a typographical error and that the amendments to claim 12 overcome the rejection.

D. Claim 13

The Examiner maintains that claim 13 is indefinite because the term “a first responsive Internet address” is unclear because the meaning of a “responsive” Internet address is vague. Applicants have deleted the term “responsive” from claim 13 (as well as dependent claim 16).

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/599,534

E. Claims 14-17

Since claims 14-17 were rejected under 35 U.S.C. § 112, second paragraph, because they are dependent upon claim 13, Applicants submit that the amendments to claim 13 overcome the rejection.

F. Claim 18

Applicants submit that the amendments to claim 18 overcome the rejection. Also, Applicants have amended claim 18 to correct minor typographical errors.

G. Claims 19-21

Since claims 19-21 were rejected under 35 U.S.C. § 112, second paragraph, because they are dependent upon claim 18, Applicants submit that the amendments to claim 18 overcome the rejection of claims 19-21.

H. Claim 26

Applicants submit that original claim 26 is definite and satisfies the requirements of 35 U.S.C. § 112, second paragraph, for reasons that are similar to reasons why original claim 5 is definite. Nonetheless, since claim 26 has been canceled without prejudice or disclaimer, the rejection of the claim is moot.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/599,534

I. Claims 27-31

Since claims 27-31 were rejected under 35 U.S.C. § 112, second paragraph, because they were dependent upon canceled claim 26, Applicants submit that the discussion above likewise traverses the rejection of claims 27-31.

J. Claim 34

Applicants submit that the amendments to claim 34 overcome the rejection. Also, Applicants have amended claim 34 to correct minor typographical errors.

K. Claims 35-37

Since claims 35-37 were rejected under 35 U.S.C. § 112, second paragraph, because they are dependent upon claim 34, Applicants submit that the amendments to claim 34 overcome the rejection of claims 35-37.

III. Rejection under 35 U.S.C. § 102(a) over WO 99/35595 to Lahtinen et al.

(“Lahtinen”)

Claims 1-6 and 22-25 have been rejected under 35 U.S.C. § 102(a) as being anticipated over Lahtinen.

A. Claim 1

Applicants submit that claim 1 is patentable over the reference. For example, claim 1 states that the protocol converting controller selects a first upstream Internet address corresponding to the destination address, which is contained in the first upstream mobile terminal

message and which corresponds to a mobile terminal communication protocol. On the other hand, Lahtinen does not disclose or suggest the feature above.

For example, in Lahtinen, the controller 2 seems to select a URL address based on a “code” transmitted from the telephone 1. However, the reference does not teach that the controller 2 selects URL addresses corresponding to a destination address which corresponds to a mobile terminal communication protocol.

B. Claims 2-4

Since claims 2-4 depend upon claim 1, Applicants submit that they are patentable at least by virtue of their dependency.

C. Claim 5

Since claim 5 has been canceled without prejudice or disclaimer, the rejection of such claim is moot.

D. Claim 6

Applicants submit that claim 6 is patentable over Lahtinen. In fact, on page 4 of the Office Action, the Examiner acknowledges that the reference does not expressly teach any of the features recited in the claim. Namely, the Examiner acknowledges that Lahtinen does not expressly suggest: a protocol converting controller (1) that determines if a first upstream mobile terminal message is part of an existing session with an Internet application, (2) that selects a first selected Internet address as a first upstream Internet address when the first upstream mobile terminal message is part of the existing session, and (3) that selects a second selected Internet address as the first upstream Internet address when the first upstream mobile terminal message is not part of the existing session.

However, despite the failure to expressly teach any of the claimed features, the Examiner contends that each and every feature of the claim is inherently disclosed. The only rationale that the Examiner provides for his position is that all of the claimed features must be performed for the Lahtinen device “to convert between the SMS and Internet protocols.”

Applicants submit that the Examiner has not set forth the requisite proof to demonstrate that the features recited in claim 6 are inherent and must be performed by Lahtinen’s proxy server 2. For example, as stated in M.P.E.P. § 2112, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Assuming that the proxy server 2 in the reference converts between the SMS and Internet protocols, such operation does not require the server 2 to (1) determine if a first upstream mobile terminal message is part of an existing session with an Internet application, (2) select a first selected Internet address as a first upstream Internet address when the first upstream mobile terminal message is part of the existing session, and (3) to select a second selected Internet address as the first upstream Internet address when the first upstream mobile terminal message is not part of the existing session. In fact, the Lahtinen system clearly can operate without determining whether or not an SMS message transmitted from the telephone 1 to the server 2 is part of an existing session with an Internet application.

For example, as described in the reference, the user of the telephone 1 can input an actual URL address, and the proxy server 2 can use this address to retrieve a webpage from the Internet

3. (Page 4, lines 26-30). Alternatively, the user can input a code corresponding to a URL address via the telephone 1, and the proxy server 2 can use the corresponding URL address to retrieve a webpage from the Internet 3. (Page 5, lines 7-16). Clearly, the proxy server 2 can perform the necessary functions for retrieving a webpage without determining if the communication from the telephone 1 is part of an existing session with an Internet application. Moreover, the server 2 clearly does not need to select a first Internet address when the communication from the telephone 1 is part of the existing session or select a second Internet address when the communication is not part of the existing session.

In light of the discussion above, Applicants submit that Lahtinen does not inherently or expressly disclose any of the features of claim 6 and that claim 6 is patentable.

E. Claim 22

Since claim 22 recites features that are similar to the features recited in claim 1, Applicants submit that claim 22 is patentable for reasons that are similar to the reasons presented above.

F. Claims 23-25

Since claims 23-25 depend upon claim 22, Applicants submit that such claims are patentable at least by virtue of their dependency.

IV. Rejection under 35 U.S.C. § 103(a) over Lahtinen and U.S.P. 6,237,033 to Doeberl et al. (“Doeberl”)

Claims 11 and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lahtinen in view of Doeberl. As a preliminary matter, claims 11 and 32 have been rewritten in independent form.

Also, even assuming *arguendo* that one skilled in the art would have been motivated to combine the teachings of Lahtinen and Doeberl, such a combination would not suggest the claimed invention. For example, Doeberl suggests creating cookies that are stored, via a browser, on a user's computer when the user is accessing pages on the Internet. (Column 1, lines 15-25). Therefore, if the teachings of Doeberl is incorporated into the teachings of Lahtinen, the resultant device would store cookies, via a browser, in the telephone 1, which the user uses in Lahtinen to access pages on the Internet.

On the other hand, claim 11 states that the protocol converting controller receives a first downstream Internet message (containing a cookie) and determines if the Internet application requires the cookie to appropriately process the first upstream Internet message. Since claim 11 states that the protocol converting controller processes the cookie, and not a mobile terminal, claim 11 would not have been obvious over Lahtinen and Doeberl. Also, since claim 32 contains features that are analogous to the features recited in claim 11, Applicants submit that claim 32 is likewise patentable.

V. Additional matters

Upon reviewing the application, Applicants realized that claim 33 erroneously depends upon claim 22. Applicants have amended claim 33 so that it depends upon claim 32. Also, in claims 7-10, the term "protocol converting controller" was erroneously written as "protocol converter controller." Accordingly, Applicants amended the claims to correct this error.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/599,534

VI. Newly added claims

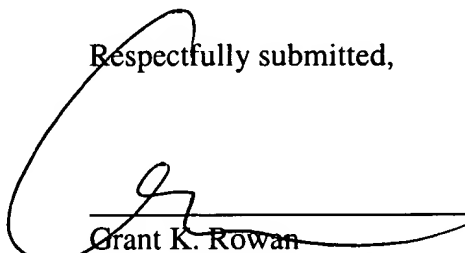
Applicants have added new claims 38-42 to provide more varied protection for the invention.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Grant K. Rowan
Registration No. 41,278

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: August 4, 2004